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UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

ABDUL REHMAN KARIM SALEH,

Plaintiff,

v.

SULKA TRADING LTD.; and A. SULKA
TRADING COMPANY LIMITED,

Defendants.

CIVIL ACTION

No.

DECLARATORY JUDGMENT COMPLAINT

Plaintiff Abdul Rehman Karim Saleh, through his undersigned counsel, hereby alleges as follows:

Nature Of The Case

1. Plaintiff Abdul Rehman Karim Saleh (“Saleh” or “Plaintiff”) is using the trademark SULKA in connection with clothing items in U.S. Commerce. Defendants own several U.S. trademark registrations for same and have claimed rights in the SULKA mark in U.S. Commerce. However, Defendants have for several years abandoned all use of that mark in commerce in the United States and has lost all trademark rights therein. Nevertheless, Defendants falsely insist that they have continued to use that mark and have trademark rights, and that any use by Plaintiff would infringe their rights. Saleh accordingly seeks a declaratory judgment that Defendants have abandoned their rights in that mark, and for an order cancelling Defendants’ trademark registrations.

Jurisdiction

2. The Court has jurisdiction over this matter pursuant to 28 U.S.C. § 2201 in that there is an actual and real controversy among the parties as to whether Defendants have extant trademark rights in the mark SULKA or have abandoned same, and whether Plaintiff may use such mark in connection with clothing items and other goods in U.S. Commerce; pursuant to 28 U.S.C. §§ 1331 and 1338 to the extent the controversy concerns such trademark rights under federal law, including the Trademark Act of 1946, 15 U.S.C. § 1051, *et seq.*, and pursuant to 28 U.S.C. §§ 1367 and 1338(b) to the extent the controversy concerns trademark rights under state and common law.

Plaintiff and Its Business Plans to Use the SULKA Mark

3. Plaintiff Saleh is an individual with an address at 7B Shiva Tower Sukhumvit Soi 15, Bangkok 10110, Thailand.

4. Saleh has applied to register the trademark SULKA in connection with “luggage, wallets, purses, computer laptop cases, handheld PC cases” and “shirts, dresses, neckties, belts, pants, scarves” in the United States Patent and Trademark Office, Serial No. 88/021619. The application is pending.

5. Saleh has commenced using the SULKA mark in U.S. Commerce in connection with apparel items, as follows:

- a. Saleh entered into a partnership with another individual in India, whose purpose is to manufacture and market apparel and other goods, including under the trademark SULKA. Plaintiff has

licensed his trademark rights to the partnership and any succeeding business entity.

- b. The partnership owns and operates the website *sulka-phulka.com* which currently offers apparel products for sale. Photographs of the products offered for sale on the website in connection with the SULKA mark are attached as Complaint Exhibit A. The website currently offers goods for sale to the United States, as well as to India, each in their local currencies, with shipping to the respective countries. The partnership has plans to expand the offerings to other countries as well, each in their respective currencies.

6. In addition, Saleh and his partner have initiated the process of using Amazon.com and other selling platforms, such as Alibaba.com and eBay.com, to offer and sell the same product offered on the *sulka-phulka.com* website to the United States and other countries. Saleh expects this process to be complete in approximately one month, by which time the same goods will also be offered for sale to the United States through one or more of these other selling platforms.

7. Thus, Saleh and his partner are using the SULKA mark for apparel products to identify goods offered in U.S. commerce.

Defendants and Their Abandoned Trademark

8. Defendant Sulka Trading Ltd. is a corporation organized under the laws of the British Virgin Islands, having an address at Citco B.V.I. Limited, Wickhams Cay, P.O. Box 662 Road Town, Tortola, British Virgin Islands (“Sulka Trading”).

9. Defendant A. Sulka Trading Company Limited is a United Kingdom company having an address at 15 Hill Street, London W1J 5QT, United Kingdom (“A. Sulka”). Both Defendants together are referenced herein as the “Sulka Defendants.”

10. The Sulka Defendants are the successors to prior businesses or entities that used the mark SULKA in the U.S. and foreign commerce, in connection with various goods. Defendants at various times relevant to this action have claimed ownership of the following U.S. Trademark registrations: Nos. 4,998,527, 4,998,512, 2,077,773, 826,139, and 310,430, for various clothing items and related goods and services (collectively the “SULKA Registrations”) (This list does not include cancelled or abandoned registrations), as well as common law rights in the mark SULKA.

11. Despite maintenance of these registrations, the Sulka Defendants have in fact not used the mark in U.S. commerce for any of the goods listed in its registrations, or indeed any goods, for more than three years, and upon information and belief, for significantly longer than three years. During this period of time, the Sulka Defendants discontinued use of the SULKA mark with intent not to resume such use and made no bona fide use of such mark in the ordinary course of trade. Any “use” of the mark during this period was made merely to reserve a right in the SULKA mark. Accordingly, the Sulka Defendants have abandoned and lost all rights in the SULKA mark.

The Controversy

12. On August 28, 2018, Plaintiff's counsel wrote to the Sulka Defendants' house counsel outlining his client's plans to enter the U.S. market and setting forth his client's position that Defendants had abandoned their trademark rights in the SULKA mark. The Sulka Defendants replied through U.S. outside counsel on August 31, 2018, and the parties exchanged further correspondence on September 6 and September 14, 2018. The Sulka Defendants, through their counsel, have continued to maintain that they did not abandon their trademark rights, that any use by Plaintiff of the SULKA mark as per his plans would infringe their rights, and demanded that Plaintiff cease his plans and abandon his pending trademark application. The September 14 correspondence from the Sulka defendants' counsel thus concluded:

[B]ased on the information that we have provided to you in good faith and based on our client's past sales which clearly show no lengthy period of non-use, we reiterate our request that your client amicably resolve any potential conflict here by willingly withdrawing both his Thailand and US applications for SULKA. We also ask that he confirm that he agrees to drop any plans to use SULKA. As you must know, the brand is of international importance to Richemont.

This letter is written without prejudice to any of our client's rights, remedies or defenses, all of which are reserved.

("Richemont" is apparently a reference to the Sulka Defendants' parent company.)

13. On July 19, 2019, one of the Sulka Defendants, A. Sulka Trading Company Limited, filed a document in an administrative proceeding in the Indian Trademark Office covering registration of the SULKA mark in India, which proceeding

involves both that Sulka Defendant and Mr. Saleh and his partner. Among other things, the document references the above correspondence and states:

That the adoption [by Saleh of the SULKA mark] is willful and deliberate is also evident from the fact that on August 28, 2018, Mr. Saleh's counsel wrote to the Registered Proprietor [*i.e.*, A. Sulka] outlining its plans to enter the U.S. market. The Registered Proprietor replied on August 31, 2018, and the parties exchanged further correspondence on September 6 and September 14, 2018. The Registered Proprietor ***categorically stated that any use by Mr. Saleh of the "SULKA" mark would infringe its rights and demanded that Mr. Saleh cease his plans and abandon his pending trademark application.***

(Emphasis added). Thus, the Sulka Defendants have made their position clear – they have not abandoned rights to the SULKA mark, and any use by Mr. Saleh of that mark in connection with apparel items in the United States or elsewhere would be an act of trademark infringement, indeed willful infringement.

14. Plaintiff, on the other hand, maintains that the Sulka Defendants have abandoned their trademark rights in the mark SULKA, and accordingly he may market clothing and leather goods items in the United States under the mark SULKA and that any use by Plaintiff of the mark SULKA would not infringe any rights of the Sulka Defendants under 15 U.S.C. §§ 1114(1) and 1125(a), the common law, or any state law.

15. There is accordingly a real case and controversy between the parties as to their respective rights in the SULKA mark.

WHEREFORE plaintiff Saleh requests the following relief:

(1) A declaration that the Sulka Defendants have abandoned and lost all trademark rights in the United States in connection with the mark SULKA; that

plaintiff Saleh is free to use that mark in connection with the goods listed in his pending trademark application in U.S. commerce, or at least in connection with the goods currently on offer on his and his partner's website (as shown in Complaint Exhibit A), and that any such use by plaintiff Saleh of the mark SULKA would not infringe any rights of the Sulka Defendants under 15 U.S.C. §§ 1114(1) and 1125(a), the common law, or any state law.

(2) Cancellation of the Sulka Registrations (Nos. 4,998,527, 4,998,512, 2,077,773, 826,139, and 310,430) pursuant to 15 U.S.C. § 1119.

(3) Attorney's fees and costs of the action.

(4) Such other relief as the Court deems just and equitable.

Dated: September 12, 2019

SPRINGUT LAW PC

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COMPLAINT EXHIBIT A

CARE THE EARTH T-SHIRT



GREEN GIRL T-SHIRT



SAVE EARTH T-SHIRT



EAT HEALTHY T-SHIRT



CHILDREN LOVES NATURE T-SHIRT



LIFE IS BEAUTIFUL T-SHIRT



LOVE EARTH SAVE EARTH T-SHIRT

